

### **REMARKS**

Claim 5 has been amended herein to correct a typographical error. Claims 21-35 have been added. Claims 1-35 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### **Status of Claims**

Claims 1-5, 14-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Do, et al. 6,206,284 (“Do”).

Claims 6-13, 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Do in view of Isozaki et al. 4,919,058 (“Isozaki”).

These rejections are respectfully traversed.

### **The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To

establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic

knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

#### **The Do Reference**

Do is directed to an ATM. The ATM includes a door member (10b) which is swing-mounted on a box portion (10a) via a hinge plate (29) at hinge points (16) located on an interior wall of the box portion and at hinge points (18) located on the door member (Figure 2; Column 2, lines 61-64).

#### **The Isozaki Reference**

Isozaki is directed to an ATM (50). The ATM includes a front panel (52) which permits a portion of an internal module (58) to protrude through an aperture (54) in the panel. When the module is withdrawn from the aperture, a vertically slidable shutter (2) closes the aperture responsive to movement of the module away from the panel (Figure 1; Column 3, lines 20-32). The shutter slides to open the aperture responsive to movement of the module towards the panel. Movement of the shutter is controlled by an arm (4) which pivots responsive to the position of the module (Column 4, lines 13-26).

**The Features Recited in Applicants' Claims  
Patentably Distinguish Over Do**

In the Action claims 1-5, 14-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Do. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretation of Do. Thus, any change in the Office's interpretation of Do shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that the Do reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features and relationships recited in Applicants' claims patentably distinguish over the Do reference.

**Claim 1**

Claim 1 is an independent claim which is specifically directed to an apparatus including an automated banking machine housing and an automated banking machine fascia. Claim 1 recites that the fascia includes a plurality of automated banking machine input and output device access openings. The fascia is also connected to the housing. Claim 1 also recites that the fascia is movable in and out of the housing between a docked position and an extended position. In the extended position the fascia is operative to tilt relative to the housing to a tilted position.

The Action asserts that Do discloses a fascia with the customer interface module (12) of Do. The Action also asserts that Do discloses that the customer interface module is pivotal and therefore tilts relative to the housing of the ATM.

However, the mere showing that Do shows a pivotal customer interface module does not disclose or suggest each of the features and relationships recited in claim 1. For example, claim 1 recites an automated banking machine fascia that moves between three different positions of: “a docked position”, “an extended position”, and “a tilted position”. Applicants respectfully submit that Do does not disclose an ATM capable of moving between these three recited positions.

Do teaches that the customer interface module (12) is mounted to a door member (10b). The door member is swing-mounted on a box portion (10a) via a hinge plate (29) at hinge points (16) located on an interior wall of the box portion and at hinge points (18) located on the door member (Figure 2; Column 2, lines 61-64). The Action appears to regard the closed position of the door member as corresponding to the recited “docked position”. However, the Action does not address where Do teaches both of the recited “extended position” and the recited “tilted position” for its customer interface module.

Claim 1 recites that the fascia moves between the “docked position” and the “extended position” and then, at the “extended position”, the fascia tilts relative to the housing to a “tilted position”. Do only shows a door member (10b) which is capable of pivoting with respect to the box portion (10a). Immediately when the door member is opened, the door member begins to tilt relative the box portion. Thus it is assumed that the Office contends that an open position of the door member corresponds to the recited “tilted position”. However, if the open position corresponds to the recited “titled position”, then where does Do teach the recited “extended position”?

The door member of Do always pivots (or tilts as alleged in the Action) from the closed

(the alleged docked position) to an open position (the apparently alleged tilted position). Do does not disclose or suggest any position which would correspond to the recited “extended position”. Nowhere does Do disclose an intermediate position of the door member between the closed/docked position and the open/tilted position of the door member. Thus nowhere does Do disclose or suggest the recited feature of a fascia that “is movable in and out of the housing between a docked position and an extended position”. Further, nowhere does Do disclose or suggest the recited feature that “in the extended position the fascia is operative to tilt relative to the housing to a tilted position”. Do does not disclose or suggest moving its customer interface panel to an extended position at which point it is operative to tilt.

Do does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Applicants’ claim 1 patentably distinguishes over the Do reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that claims 2-19 which depend from claim 1 are likewise allowable.

## **Claim 2**

Claim 2 depends from claim 1 and recites that the fascia is operative to move in a generally horizontal direction in and out of the housing. Do does not disclose or suggest that its customer interface module (12) moves in and out of the box portion (10a) or the top module (14). Thus claim 2 is not anticipated by Do and it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

### **Claim 3**

Claim 3 depends from claim 2 and recites that the fascia is horizontally slidable in and out of the housing. Do does not disclose or suggest that its customer interface module (12) is capable of sliding in and out of the box portion (10a) or the top module (14). Thus claim 3 is not anticipated by Do, and it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

### **Claim 19**

Claim 19 depends from claim 17 and is directed to a method of operating the apparatus recited in claim 17. Claim 19 recites a step (b) of tilting the fascia relative to the housing to a tilted position. Claim 19 specifically recites that step (b) occurs subsequent to a step (a) of moving the fascia from the docked position to the extended position.

Nowhere does Do disclose or suggest that the pivoting or tilting of its customer interface module (12) occurs subsequent to moving the customer interface module from a docked position to an extended position. As discussed previously with respect to claim 1, the customer interface module pivots immediately upon being moved from the closed position. Thus Do does not disclose or suggest the recited steps of moving a fascia from a docked position to an extended position and then subsequently tilting the fascia to a tilted position.

In addition, claim 19 also recites a step (c) of tilting the fascia relative to the housing to a non tilted position which occurs subsequent to step (b). In addition, claim 19 recites a step (d) of moving the fascia from the extended position to the docked position which occurs subsequent to step (c).

Nowhere does Do disclose or suggest pivoting or tilting of its customer interface module (12) from a tilted position to a non tilted position and then subsequently moving the customer interface module to a closed position. Thus Do also does not disclose or suggest the recited steps of moving a fascia to a non tilted position and then subsequently moving the fascia to a docked position.

For these reasons, claim 19 is not anticipated by Do and it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Do in view of Isozaki**

In the Action claims 6-13 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Do in view of Isozaki. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretations of Do and Isozaki. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

**Claim 20**

Claim 20 is an independent claim which is directed to an apparatus including a cash dispensing automated banking machine. Applicants respectfully submit that Do and Isozaki do



not disclose or suggest each of the features recited in the claims. For example, claim 20 recites that the machine includes a fascia connected to a housing, and that the fascia includes rollers. Claim 20 also recites that the fascia is horizontally movable via the rollers in and out of the housing between a docked position and an extended position.

Do does not disclose or suggest a fascia that is horizontally movable via rollers. However, the Action contends that Isozaki discloses a roller (8) attached to the fascia which supports or retains the fascia when the fascia is closed in the docked position. Applicants respectfully disagree.

The roller (8) in Isozaki does not support or retain the fascia. The roller (8) is provided on a arm (4) which pivots on a pivot (10). The pivoting of the arm is operative to open and close a shutter (2) on the front panel (52). The arm pivots responsive to movement of an internal module (58) which contacts the roller (Figure 1; Column 3, lines 20-32; Column 4, lines 13-26). Nowhere does Isozaki disclose or suggest that the roller (8) either supports or retains the front panel (52). Further, nowhere does Isozaki disclose or suggest that its front panel is even movable. Thus the applied art does not disclose or suggest the recited feature: **wherein the fascia is horizontally movable via the rollers.**

As discussed previously with respect to claims 1 and 2, Do does not disclose or suggest a fascia that is movable (either with or without rollers) into and out of a housing. As Isozaki does not even disclose or suggest that its front panel (52) is capable of moving in and out of a housing, it follows that the applied art does not disclose or suggest the recited feature: **wherein the fascia is horizontally movable via the rollers in and out of the housing between a docked position and an extended position.**

Also as discussed previously with respect to claim 1, Do does not disclose or suggest that a fascia moves between all three of the separate positions of: “a docked position”, “an extended position”, and “a tilted position”. As Isozaki does not even disclose or suggest that its front panel (52) is capable of moving in and out of a housing, it follows that the applied art does not disclose or suggest the recited feature: wherein the fascia is horizontally movable via the rollers in and out of the housing **between a docked position and an extended position, wherein in the extended position the fascia is operative to tilt relative to the housing to a tilted position.**

In addition, claim 20 recites that the housing includes at least one projection which is operative to limit outward movement of the fascia relative to the housing. Claim 20 further recites that the fascia includes at least one hook member operative to catch on a respective projection. Claim 20 also recites that in the extended position the fascia is operative to tilt by pivoting on the projection.

The Action admits that Do and Isozaki do not disclose the recited hook member. However, the Action states that Official Notice is taken that hook fastening means and pull handles for releasing the hooks on closable housing structures are old and well known. The Action then contends that “It would have been obvious . . . to provide Do as combined with Isozaki with a hook latch mechanism in order to positively and securely fasten the fascia in a closed position, and to provide Do as combined with Isozaki with a pull handle for releasing the hook in order to allow the fascia to be opened”. Applicants disagree.

First, the Action appears to have confused the recited element of the “hook” with the recited element of the “latch”. Claim 20 recites that the “pull handle is operative to be actuated to move the latch bolt from the locking position to the non locking position enabling the fascia to

move relative to the latch bolt toward the extended position”. Claim 20 does not recite a relationship between the recited “pull handle” and the recited “hook” as alleged in the Action. Further, Claim 20 does not recite that the recited “hook” has anything to do with positively and securely fastening the fascia in a closed position as asserted in the Action.

Rather, claim 20 recites that the hook is an element of the fascia which catches the projection of the housing. In the extended position the fascia is operative to tilt by pivoting on the projection. See for example: Figure 43 of the Specification which shows an example of a hook 510 pivoting about a projection 508; Figure 40 which shows the fascia 504 in the tilted position with respect to the housing 502; and Page 21, line 12 to page 22, line 5.

Nowhere do Do and Isozaki disclose or suggest a movable fascia with a hook member that catches on a projection of the housing and then pivots about the projection to tilt a fascia with respect to the housing. In addition, the asserted Official Notice regarding hook fastening means and pull handles also does not provide any evidence of a prior art hook which catches on a projection of a housing and pivots about the projection to tilt the fascia of an automated banking machine.

The applied references do not disclose or suggest each of features and relationships recited in claim 20, and the Office has not established *prima facie* obviousness. Also, as nothing in the cited art discloses or suggests numerous features and relationships that are specifically recited in the claim, and because there is no prior art teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants’ invention, it is respectfully submitted that claim 20 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

### **Claim 6**

Claim 6 depends from claim 5 and recites that each stop comprises a projection and each member comprises a hook member. Claim 5 also recites that each respective hook member is operative to catch on a respective projection.

As discussed previously with respect to claim 20, neither Do nor Isozaki discloses or suggests a hook member of a fascia which is operative to catch on a respective projection of the housing.

The Office has not established *prima facie* obviousness with respect to claim 6, and it is respectfully submitted the rejection should be reversed.

### **Claim 7**

Claim 7 depends from claim 6 and recites that in the extended position the fascia is operative to tilt by pivoting on the projection. As discussed previously with respect to claim 20, neither Do nor Isozaki discloses or suggests a fascia which moves between docked, extended and tilted positions. In addition, neither reference discloses or suggests a fascia that catches a hook on a projection of the housing and in the extended position tilts by pivoting on the projection.

The Office has not established *prima facie* obviousness with respect to claim 7, and it is respectfully submitted the rejection should be reversed.

### **Claim 8**

Claim 8 depends from claim 2 and recites that the fascia includes rollers, wherein the fascia is movable relative to the housing on the rollers. As discussed previously with respect to

claim 20, neither Do nor Isozaki discloses or suggests a fascia that moves on rollers. Do only shows a door (10b) and customer interface module (12) which pivots relative a box portion (10). In addition, Isozaki does not disclose or suggest that its front panel is capable of moving on the roller (8). Further, Isozaki does not even disclose or suggest that its front panel (52) is even capable of moving relative to a housing of an automated banking machine.

Thus the applied art does not disclose or suggest a fascia of an automated banking machine that is movable relative to the housing on the rollers. The Office has not established *prima facie* obviousness with respect to claim 8, and it is respectfully submitted the rejection should be reversed.

#### **Claim 9**

Claim 9 depends from claim 8 and recites that the fascia is operative to tilt relative to the housing only when in the extended position. Claim 9 also recites that when the fascia is in the tilted position, at least one roller is located out of the housing and at least one other roller is located in the housing.

As discussed previously with respect to claim 20, neither Do nor Isozaki discloses or suggests a fascia which moves between docked, extended and tilted positions. In addition, neither reference discloses or suggests a fascia that is only operative to tilt relative to the housing when the fascia is in the extended position.

Also, although Isozaki shows a roller (8) on a pivoting arm (4) which is used to move a shutter (2), nowhere does Isozaki show two rollers. Nowhere does Isozaki disclose or suggest that when its front panel (52) is in a tilted position, one of the rollers is located out of a housing

and one of the rollers is located in the housing. Further as discussed previously, Isozaki does not even show that its front panel is capable of moving to a tilted position.

The Office has not established *prima facie* obviousness with respect to claim 9, and it is respectfully submitted the rejection should be reversed.

### **The New Claims**

Claim 21 is an independent claim which is specifically directed to an automated banking machine which comprises: a housing; a cash dispenser; a fascia; and at least one roller. The at least one roller is operative to support the fascia in movable supporting connection with the housing when the fascia moves with respect to the housing in a horizontal direction between a first position and a second position. Claim 21 also recites in the first position the fascia is constrained to move only in the horizontal direction and when the fascia is in the second position, the fascia is enabled to pivot relative to the housing such that at least a portion of the fascia moves in a vertical direction.

Claim 29 is an independent claim directed to a method. The method comprises moving a fascia of a cash dispensing automated banking machine in a first horizontal direction from a first position to a second position with respect to and in supporting connection with a housing of the automated banking machine. In addition, claim 29 recites with the fascia in the second position, pivoting the fascia relative to and in supporting connection with the housing in a first rotational direction such that at least a portion of the fascia moves in a vertical direction.

New claims 21 and 29 recite subject matter found in original claims 1, 8, and 19. New claims 22-28 and 30-35 depend respectively from independent claims 21 and 29. Support for

new claims 21-28 and 30-35 is found in the original claims 2-9. Also, support for new claims 21-35 is found in Figures 35-43 and Page 20, line 15 to page 22, line 9.

None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claims 21-35. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses or suggests the features, relationships and steps that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

#### **Additional Claim Fees**

Please charge the fees associated with prosecution of one additional independent claim in excess of three (\$200) and fifteen additional total claims (\$750) and any other fee due, to Deposit Account No. 09-0428 of Diebold Self-Service Systems.

### Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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